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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Professional Direct Agency, Inc., by assignment, change-of-name and merger from Info-One Technology, Inc.[1]

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Serial No. 75/499,673

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Gregory N. Owen of Owen, Wickersham & Erickson PC for applicant.

Sharon A. Meier, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

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Before Chapman, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 10, 1998, the original applicant, Info-One Technology, Inc. (a California corporation), filed an application to register the mark INFO-ONE on the Principal Register for the following goods in International Class 9:

[1] The record of the Assignment Branch of the USPTO for the involved application Serial No. 75/499,673 consists of four recorded transfer-of-interest documents.

> "computer software, namely, a comprehensive set of applications and templates for building business and marketing management solutions for use on electronic communication networks, namely, user interface, html browsing, file management, electronic mail, enterprise data access, facilitating individual and group communication, and personal information management functionality; computer software for searching and retrieving information, sites and other resources on electronic communication networks; computer software for accessing information on electronic communications networks; computer software for customizing the delivery of information to others via electronic communication networks; computer software for collecting and presenting news and information electronically; computer software for enabling users to buy and sell goods and services via electronic communication networks; and user manuals sold as a unit."

Applicant based its application on Section 1(b) of the Trademark Act, asserting a bona fide intention to use the mark in commerce. The mark was published for opposition on November 2, 1999, and as no opposition was filed, the Office issued a notice of allowance on January 25, 2000. Applicant filed its statement of use on July 25, 2000, claiming a date of first use and first use in commerce of September 1, 1999.

The specimen submitted by applicant is reproduced below (in reduced form).

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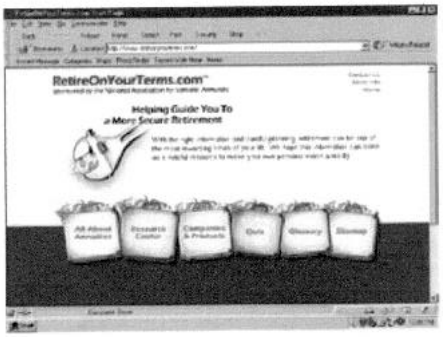

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POWERED BY infoone

7/21/00 10:29 AM

Applicant explains its goods as follows:

> [Applicant] sells access to and licenses computer application software downloadable by the customers via the Internet. This is really no different than a customer "buying" a CD-ROM of Microsoft's programs from a store. In both cases, the consumer does not actually buy the software but buys a "license" to use the programs. The difference is that the Applicant has taken an application program that

> might have been traditionally installed on a customer's machine and hosts it on its own computers. As such, Applicant's application software is not marketed in traditional physical packaging and boxes and does not lend itself to affixation of tags or labels, or placement on containers. The real "containers" for Applicant's programs are computers "run on" or "powered by" the application program which display Applicant's mark on their screens. While a computer is not a traditional container, it should be noted that there is nothing traditional about the Internet, the pseudo-space we call "Cyberspace," and the very concept of remote downloading of computer programs. (Applicant's March 26, 2001 response to an Office action, p. 2)

Applicant explains the specimen as follows:

> In the case at hand, the specimen submitted by Applicant is a print-out of the web site of one of the Applicant's customers who links to Applicant's INFO-ONE brand application software and buys a license to use the said application in connection with the customer's Internet[-]related operations. This is clearly established by the "POWERED BY INFO-ONE" statement at the bottom left hand side of the customer's web page. Id.

Applicant contends that "as Applicant's software is web-based and delivered *exclusively* via the Internet" and "because of the unique nature of Applicant's software application—i.e., it is web-based and customizable by its

purchaser for integrated use on the purchaser's web site—the *only* way in which Applicant may display the INFO-ONE mark in association with the product is on the screen of a computer utilizing Applicant's software" (brief, p. 4, emphasis in original), this use of the mark is acceptable under the Trademark Act and the Trademark Rules of Practice.

Applicant further contends that while the display of applicant's mark may incidentally serve as an advertisement, it is clear from the usage of "powered by" that the INFO-ONE brand is used on computer software licensed by applicant, thereby creating a clear connection between the mark and the goods; that applicant's specimen should be accepted because it is impracticable to affix traditional tags or labels on applicant's programs which "are the cyber equivalent of bulk goods in that they are stored in Applicant's computers without individual packaging and are licensed to consumers in 'bulk'"[2]; that the USPTO should take a flexible approach with regard to some of the "intangibility problems" that are involved with downloadable software; and that there is no requirement

[2] Applicant also explained that it is a condition of purchasing a license from applicant for these goods that the consumer is required to display applicant's mark as part of the "POWERED BY INFO-ONE" statement.

that a purchaser see the mark as it appears on the product prior to purchase.

The Examining Attorney required a substitute specimen citing Trademark Rules 2.56 and 2.88(b)(2), and contending that the specimen of record is unacceptable because (i) it is merely advertising material showing the mark at the bottom of the advertisement, and (ii) there is nothing about the wording "powered by" that conveys to consumers that applicant provides computer software. Specifically, the Examining Attorney asserts that the specimen is a printout of a purchaser's web page utilizing applicant's software, but with no indication that the mark is used in connection with computer software or that applicant's software could be downloaded by clicking on the "INFO-ONE" button; that applicant has made no showing that it is impracticable to use the mark in ways that are traditionally acceptable for computer software (e.g., labels affixed to CD-ROMs, printed on instruction manuals, printed on the containers for software, printouts of display screens showing the trademark for computer software, for downloadable software use on a web page indicating that the software is downloadable); that applicant's advertisement on a client's web page is not an acceptable specimen to show trademark use; that simply

advertising software on a web page with no way to download it remains mere advertising; that, in fact, clicking on the "INFO-ONE" button simply launches the person to applicant's website; that "powered by" could "just as easily signify" (brief, p. 8) not that applicant provides the computer software, but that applicant designed and created the website, or the website is hosted or sponsored by INFO-ONE, or that it is merely a hotlink or banner advertisement for INFO-ONE goods and services; and that nothing in the wording "powered by INFO-ONE" conveys to the consumer that applicant provides computer software. In sum, the Examining Attorney finds applicant's use of INFO-ONE as shown on the specimen is purely advertising in nature and consumers would view it as such; and that there is no acceptable specimen evidencing actual trademark use of the mark for the identified goods.

Applicant has appealed, and briefs have been filed.[3] Applicant did not request an oral hearing.

The issue before the Board is whether the specimen submitted with applicant's statement of use is an acceptable specimen of use of the mark INFO-ONE for the

[3] Applicant submitted a few exhibits for the first time with its reply brief on appeal. The Board did not consider these untimely exhibits. See Trademark Rule 2.142(d), and TBMP §1207.01.

computer software identified the application.

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "use in commerce" on goods as when "(A) it [the mark] is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce..."

Trademark Rule 2.56 regarding the requirements for specimens reads, in pertinent part, as follows:

> (a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.
>
> (b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

The Board has been somewhat liberal in assessing the acceptability of materials which have been submitted as specimens of use. See, e.g., In re Ancha Electronics Inc., 1 USPQ2d 1318 (TTAB 1986); In re Shipley Co. Inc., 230 USPQ 691 (TTAB 1986); In re Ultraflight Inc., 221 USPQ 903 (TTAB

1984); and In re Brown Jordan Company, 219 USPQ 375 (TTAB 1983).

Applicant has clearly explained its goods, which are not in tangible form, but rather exist only in "cyberspace." Thus, it is impracticable (perhaps impossible) for these goods to be marked with a tag or label in any traditional sense, including either as a document or a display associated with the goods. Here the mark appears on applicant's customer's web page, and we are convinced that the mark as shown thereon relates to the computer software programs provided by applicant. Although the Examining Attorney argues that applicant's use could refer to website design and creation by applicant, or to applicant as the website host or sponsor, or a hotlink banner advertisement, the Examining Attorney failed to put in any evidence relating to her proposed meanings of the words "powered by," and moreover, essentially acknowledges that the words "powered by" could refer to the software provided by applicant. (Brief, p. 8.) Because applicant's position is admittedly plausible, we believe it was the Examining Attorney's responsibility to support her claim that "powered by" has other significance.

The Examining Attorney cites TMEP §904.04(d) (Third edition January 2002--R-1 June 2002) regarding specimens

for "downloadable" software, which reads, in relevant part, as follows:

> For downloadable computer software, the applicant may submit a specimen that shows use of the mark on an Internet website. However, such a specimen is acceptable only if the specimen itself indicates that the user can download the software from the website (e.g., if the specimen shows a download button). If the website simply advertises the software without providing a way to download it, the specimen is unacceptable.

As pointed out by applicant, the TMEP is a manual of procedure (as is the TBMP) and does not carry the same force as the law and the rules. See West Florida Seafood, Inc. v. Jet Restaurants, Inc., 31 F.3d 1122, 31 USPQ2d 1660, footnote 8 (Fed. Cir. 1994); and Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc., 41 USPQ2d 1030, 1035 (TTAB 1996). Also, we note that the above policy statement with regard to downloadable software cites to no authority in support thereof. The Board can find no authority to support the theory that if "downloadable" software is not downloadable directly from a "button" appearing on a web page, then the "button" may only be considered to be advertising. That may sometimes be the situation, but here, applicant has shown that its use of its mark is not merely advertising, but rather

evidences applicant's use of the mark on or in connection with these goods.[4]

We find that applicant's specimen, in the circumstances of this case, complies with the law and the rules.

Decision: The refusal to register based on a requirement for an acceptable specimen is reversed.

[4] Moreover, applicant's identified goods are not limited to downloadable computer software. Therefore, as identified, applicant's goods encompass non-downloadable computer software.